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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1001.1681101

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Application Number	Filed
10/630,307	July 30, 2003

First Named Inventor: Joel M. WasDyke

Art Unit	Examiner
3773	Bui, Vy Q

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

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I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 36,926
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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Telephone number
April 23, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellant has carefully reviewed the Final Office Action of December 31, 2009 and the Advisory Action of March 9, 2010. Currently, claims 13-22, 24, 31, 33, and 34 are pending in the application and have been rejected by the Examiner. Appellant hereby requests a pre-appeal conference and file this pre-appeal conference brief concurrently with a Notice of Appeal. Favorable consideration of the claims is respectfully requested.

Claims 13-22, 24, 31, 33, and 34 were rejected under 35 U.S.C. 102(b) as anticipated by Kleshinski (U.S. Patent No. 5,776,162) or in the alternative as obvious over Kleshinski under 35 U.S.C. 103(a). Claim 18 was rejected under 35 U.S.C. 103(a) as obvious over Kleshinski in view of Boylan et al. (U.S. Patent No. 6,602,272), hereinafter Boylan. Claim 22 was rejected under 35 U.S.C. 103(a) as obvious over Kleshinski as applied to claim 13 in view of Mazzocchi et al. (U.S. Patent No. 6,949,103), hereinafter Mazzocchi. Appellants respectfully traverse the rejections for at least the reasons that Kleshinski, as applied to independent claims 13 and 24, does not expressly or inherently describe each and every element as set forth in the claims and does not show the identical invention in as complete detail as is contained in the claims. As such, these claims are believed to be allowable over these references.

Pending independent claims 13 and 24 describe a blood clot filter having an apical head and a plurality of elongated filter legs, said filter legs actuatable among three configurations, namely a radially collapsed configuration, a centering configuration, and a filtering configuration. (See Figures 5-7.) Note particularly, that it is the filter legs themselves which have three distinct configurations. Each of the configurations imposes distinct limitations upon the filter legs. The collapsed configuration requires the legs, attached to the apical head at their proximal ends, to be radially collapsed. The centering configuration requires that each filter leg includes a bend region in the proximal section, generally proximate the apical head, which forms a pad configured to abut the wall of a blood vessel such that the legs extend outward from the central longitudinal axis at equidistant intervals to center the filter when placed within a blood vessel. In the filtering configuration, each filter leg is configured to avoid contact between the vessel wall and the proximal section of the filter leg which included the abutting pad of the centering configuration.

The filter disclosed by Kleshinski is described as a double filter having a first filter basket 16 and a second filter basket 18. (Fig. 1, Col. 3, lines 23-25.) Neither filter basket is described as having component legs possessing the characteristics recited in claims 13 and/or 24. In the Advisory Action, the Examiner has asserted that "the claim languages of the present invention do not exclude the case when the centering configuration defined by filter legs 20 of Kleshinski-'162) and filtering configuration defined by the filter legs 22 of Kleshinski-'162 co-exist in a blood vessel." This is both correct and immaterial to the question to be resolved, namely whether either the filter legs of the set of seven filter legs 20 of filter basket 16 or the filter legs of the set of six filter legs 22 of filter basket 18 each anticipate or otherwise render obvious the filter legs of the present claims.

The two separate filter baskets of Kleshinski are well differentiated from each other in structure and function:

> "The mesh of first filter basket 16 is formed from the sections of wires between the two quarter-inch coils 12 and 14. The mesh is made up a series of seven overlapping loops 20 arranged to form a rosette approximately 25 mm in diameter. ... The peripheral portions or tips of the loops 20 press outwardly against the inner wall of the vein, although without becoming imbedded in the vein; loops 20 thereby help to keep filter 10 in place." (Col. 3, lines 30-43.)

> "The mesh of second filter basket 18 is formed by the six circumferentially spaced free wire ends or legs 22, which tilt and bow outwardly of the longitudinal axis of filter 10. The six free ends or legs 22 that extend beyond the second quarter inch coil 14 diverge so that their tips form a circle 24 at their maximum divergence. Each leg is also bowed outwardly slightly. The legs serve to orient the device relative to the longitudinal axis of the vena cava. ... Each free end of a leg 22 is bent sharply outward at about a right angle to form a hook 26 of approximately 1.5 mm in length. The hooks are intended to engage the wall of the vena cava to prevent migration proximally or distally." (Col. 3, lines 45-57.)

As disclosed at col. 3, lines 17-22, the filter 10 of Kleshinski has only two configurations, a collapsed martensite phase delivery configuration and an expanded austenitic preformed filtering shape. There is no centering configuration in which bends in the filter legs form pads which abut and center the filter within a blood vessel and subsequently assume a filtering configuration in which the proximal region avoids contact with the vessel wall. Although the disclosure of Kleshinski does specify bend regions 28 in legs 22, those bends are said to be located between coil 14 and the halfway point 30 along the length of each leg at a point

corresponding to approximately 70% of the diameter of the wall engaging hooks 26 and approximately 54% of the diameter of peripheral portions or tips of the loops 20 which are said to press outwardly against the inner wall of the vein. Accordingly, the bend region of Kleshinski fails to disclose pads, formed by a bend region near the proximal end of legs 22, which abut the vessel wall in a centering configuration and which avoid contact with the vessel wall in the filtering configuration. Similarly, the peripheral intermediate portions or tips of the loops 20 assume a collapsed martensite phase delivery configuration and press outwardly against the inner wall of the vein in the expanded austenitic preformed filtering shape. Any portion of said loops which might be characterized as a pad configured to abut a vessel interior wall to center the filter is both distal of the proximal bend region and necessarily remains in contact with the vessel wall in the filtering shape wherein the loops help to keep filter 10 in place.

As will be seen in the sketch provided in the Final Office Action (page 3), the Examiner has attempted to attribute the centering configuration to the seven legs 20 of filter basket 16 and an arbitrarily selected portion of the six filter legs 22 of filter basket 18, while the filtering configuration is attributed to the remainder of the six filter legs of filter basket 18. If the legs 20 of basket 16 provide the proximal region centering pads which abut the vessel wall, they do not avoid contact with the vessel wall in the filtering configuration, but explicitly remain in contact to "help to keep filter 10 in place". If the legs 22 of basket 18 are to provide the filtering configuration which avoids contact with the vessel wall in the filtering configuration, they do not provide a centering configuration in which a proximal bend region contacts the vessel wall and subsequently avoids contact with the vessel wall. Thus neither set of legs anticipates or renders obvious the filter legs of the pending claims 13 and 24. Appellant respectfully requests that the rejections of independent claims 13 and 24 under 35 U.S.C. 102(b) and/or under 35 U.S.C. 103(a) be overruled for at least the reasons that Kleshinski does not expressly or inherently describe each and every element as set forth in the claims. Claims 14-17, 19-21, 31, and 33-34, which depend from claims 13 and 24 respectively, and include significant additional limitations, are believed to be not anticipated by Kleshinski and Applicant respectfully requests that the rejections be withdrawn.

Further, Kleshinski does not appear to teach all the claim limitations recited in independent claims 13 and 24, as is required to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a).

Neither Boylan nor Mazzocchi overcome the deficiencies of Kleshinski as applied to independent claim 13.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 14-17, 19-21, 31, and 33-34, which depend from nonobvious independent claims 13 and 24 respectively, also are believed to be nonobvious and Appellant respectfully requests that the rejections be overruled.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: April 23, 2010

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